

REMARKS

The Office Action mailed January 12, 2005, has been received and reviewed. Claims 2-5, 7-25, 35, and 36 are currently pending in the application. Claims 1 through 25 stand rejected. Applicants have cancelled claims 1 and 6 with claims 26-34 having been previously cancelled. Claims 35 and 36 are new. Claims 2-5, 7-11, and 15-17 have been amended herein, and respectfully requests reconsideration of the application as amended herein.

35 U.S.C. § 112 Claim Rejections

Claims 1 through 25 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection, as hereinafter set forth.

The Office Action recites, “support could not be found for having the RIC configured to provide the shut-off signal and have no outputs to or inputs from the normal utilization circuitry of the electronic appliance.” (Office Action, p.2). Such limitations were recited in claims 1, 6 and 11. While Applicants make no representation of the appropriateness of the rejection under 35 U.S.C. § 112, first paragraph, Applicants have cancelled claims 1 and 6 in favor of new claims 35 and 36 and have amended claim 11. As amended, the claims presently before the Examiner do not include the limitations in question.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 112, first paragraph, be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,748,084 to Isikoff and U.S. Patent No. 6,664,888 to Bishop

Claims 1 through 15, 19 through 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isikoff (U.S. Patent No. 5,748,084) and Bishop (U.S. Patent No. 6,664,888). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 1 through 15, 19 through 25 are improper because elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claim 1 and claims 2-5 depending therefrom, Applicants have cancelled independent claim 1 and amended claims 2-5 to depend from new independent claim 35. Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention of new independent claim 35, as well as claims 2 through 5 depending therefrom because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants submit that any proposed combination of the Isikoff reference and Bishop reference does not teach or suggest the claim limitations calling for:

35. An anti-theft device cooperatively operable with normal utilization circuits within an electronic apparatus, comprising:

a remote intelligent communication (RIC) unit configured for enablingly coupling with the normal utilization circuits, the RIC unit, including:

a control circuit including:

a memory configured to receive and store therein a unique identifier of a specific one of the electronic apparatus;

means for inputting the unique identifier into the memory at a point of sale; and

a transceiver configured to at least receive a signal;
and
a shut-off unit configured for entering a shut-off state and disabling operative power via a shut-off signal to the normal utilization circuits in response to receipt of the signal via the transceiver of a shut-off command designating the unique identifier stored in the RIC unit. (Emphasis added.)

Therefore, Applicants respectfully request the rejection of claims 2-5 now depending from new independent claim 35 be withdrawn.

Regarding independent claim 6 and claims 7-10 depending therefrom, Applicants have cancelled independent claim 6 and amended claims 7-10 to depend from new independent claim 36. Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention of new independent claim 36, as well as claims 7 through 10 depending therefrom because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants submit that any proposed combination of the Isokoff reference and Bishop reference does not teach or suggest the claim limitations calling for:

36. (New) A method of operating an anti-theft device cooperatively operable with normal utilization circuits within an electronic apparatus, the anti-theft device including a remote intelligent communication (RIC) unit and a shut-off unit, the method comprising:
coupling the anti-theft device to normal utilization circuits within an electronic apparatus;
inputting into a memory in the anti-theft device at a point of sale a unique identifier of a specific one of the electronic apparatus;
evaluating a received signal at the anti-theft device; and
entering a shut-off state and disabling operative power via a shut-off signal to the normal utilization circuits in response to receipt of the signal having therein a shut-off command designating the unique identifier stored in the memory. (Emphasis added.)

Therefore, Applicants respectfully request the rejection of claims 7-10 now depending from new independent claim 36 be withdrawn.

Regarding claims 11-15, 19 and 20 (and presumably claims 21-25 not otherwise rejected in the Office Action), Applicants have amended independent claim 11 from which claims 12-15 and 19-25 at least indirectly depend. Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding presently amended independent claim 11 from which claims 12-15 and 19-25 at least indirectly depend because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants submit that any proposed combination of the Isokoff reference and Bishop reference does not teach or suggest the claim limitations calling for:

11. An anti-theft device for shutting off an operable electronic apparatus subsequent to the electronic apparatus being stolen from its owner, the anti-theft device comprising:

a communication unit incorporated within the casing of the electronic apparatus and comprising:

***a memory configured to receive and store therein unique identifier stored data of a specific one of the electronic apparatus;
means for inputting the unique identifier stored data into the memory at a point of sale;***

a receiver for receiving a signal transmitted from an interrogator, and
a control circuit that is coupled to the receiver for determining whether the received signal designates the unique identifier stored data of the anti-theft device and, if so, for determining whether the signal includes an electronic apparatus shut-off command generated by the interrogator in response to a notification from the owner that the electronic apparatus has been stolen, and, if so, for producing a shut-off signal, and a power blocking circuit responsive to the shut-off signal for placing the electronic apparatus in a shut-off state by blocking the flow of electricity from a power source of the electronic apparatus to normal utilization circuitry of the electronic apparatus. (Emphasis added.)

Therefore, Applicants respectfully request the rejection of claims 11-15 and 19-25 be withdrawn.

Obviousness Rejection Based on U.S. Patent No. 5,748,084 to Isikoff and U.S. Patent No. 5,515,419 to Sheffer

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isikoff (U.S. Patent No. 5,748,084) and Sheffer (U.S. Patent No. 5,515,419). Applicant

respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 16 and 17 are improper because elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding claims 16 and 17, independent claim, Applicants have amended independent claim 11 from which claims 16 and 17 at least indirectly depend. Applicants submit that any proposed combination of the Isikoff reference in view of the Sheffer reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding presently amended independent claim 11 from which claims 16 and 17 at least indirectly depend because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants submit that any proposed combination of the Isikoff reference and Sheffer reference does not teach or suggest the claim limitations calling for:

11. An anti-theft device for shutting off an operable electronic apparatus subsequent to the electronic apparatus being stolen from its owner, the anti-theft device comprising:

a communication unit incorporated within the casing of the electronic apparatus and comprising:

***a memory configured to receive and store therein unique identifier stored data of a specific one of the electronic apparatus;
means for inputting the unique identifier stored data into the memory at a point of sale;***

a receiver for receiving a signal transmitted from an interrogator, and
a control circuit that is coupled to the receiver for determining whether the

received signal designates the unique identifier stored data of the anti-theft device and, if so, for determining whether the signal includes an electronic apparatus shut-off command generated by the interrogator in response to a notification from the owner that the electronic apparatus has been stolen, and, if so, for producing a shut-off signal, and a power blocking circuit responsive to the shut-off signal for placing the electronic apparatus in a shut-off state by blocking the flow of electricity from a power source of the electronic apparatus to normal utilization circuitry of the electronic apparatus. (Emphasis added.)

Therefore, Applicants respectfully request the rejection of claims 16 and 17 be withdrawn.

Obviousness Rejection Based on U.S. Patent No. 5,748,084 to Isikoff and U.S. Patent No. 5,406,261 to Glenn

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Isikoff (U.S. Patent No. 5,748,084) and Glenn (U.S. Patent No. 5,406,261). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 18 is improper because elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding claim 18, independent claim, Applicants have amended independent claim 11 from which claim 18 at least indirectly depend. Applicants submit that any proposed combination of the Isikoff reference in view of the Glenn reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding presently amended

independent claim 11 from which claim 18 depends because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants submit that any proposed combination of the Isokoff reference and Glenn reference does not teach or suggest the claim limitations calling for:

11. An anti-theft device for shutting off an operable electronic apparatus subsequent to the electronic apparatus being stolen from its owner, the anti-theft device comprising:

a communication unit incorporated within the casing of the electronic apparatus and comprising:

*a memory configured to receive and store therein unique identifier stored data of a specific one of the electronic apparatus;
means for inputting the unique identifier stored data into the memory at a point of sale;*

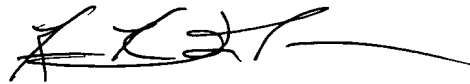
a receiver for receiving a signal transmitted from an interrogator, and
a control circuit that is coupled to the receiver for determining whether the received signal designates the unique identifier stored data of the anti-theft device and, if so, for determining whether the signal includes an electronic apparatus shut-off command generated by the interrogator in response to a notification from the owner that the electronic apparatus has been stolen, and, if so, for producing a shut-off signal, and a power blocking circuit responsive to the shut-off signal for placing the electronic apparatus in a shut-off state by blocking the flow of electricity from a power source of the electronic apparatus to normal utilization circuitry of the electronic apparatus. (Emphasis added.)

Therefore, Applicants respectfully request the rejection of claim 18 be withdrawn.

CONCLUSION

Claims 2-5, 7-25, 35 and 36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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